

on the video monitor which acts as a switch to initiate the respin" (see, p. 11, lns. 25-30). Independent claim 20 includes all of these three possibilities of designating individual boxes for respin, designating rows of boxes for respin or designating columns of boxes for respin. By contrast, dependent claim 23 is limited to designating only entire columns of boxes for respin and dependent claim 25 is limited to designating only entire rows of boxes for respin. For these reasons, Applicant submits that dependent claim 23 and 25 add valid further limitations to the scope of independent claim 20 in compliance with 35 U.S.C. § 112.

Finally, it has recently been brought to Applicant's attention that the phrase "but not all" in Applicant's U.S. Patent No. 5,704,835 and pending claims 20-30 might be construed to preclude the player from choosing *all* of the initial symbols for replacement. This "but not all" language was originally inserted into Applicant's claims to distinguish the Georgilas patent (U.S. Patent No. 5,067,712) which, to the extent any respin was allowed, *required* all of the initial symbols to be respun (see, col. 4, lns. 18-19, the "second playing cycle is, of course, played in the same way as the first..."). Applicant's invention is very different from the Georgilas patent in so far as the player (or slot machine owner) in Applicant's invention can *choose* less than all of the initial symbols for respin. Nonetheless, while it is preferred, for reasons of predictability, to limit the number of boxes that can be respun to one, there is no *prohibition* in implementing Applicant's invention to allowing the player to choose more than one, and as many as all, of the initial symbols for respin (see, col. 11, lns. 26-30 and col. 14, lns. 1-3). In order to remove any ambiguity about the proper scope of Applicant's invention, Applicant has removed the "but not all" language from claims 20-30 and indicated in the remaining claims that it is possible that no initial symbols would be left after replacement symbols are chosen.

B. Prior Art Rejections

1. The Invention

Applicant has invented a variation of the popular electronic slot machine game in which a plurality of electronically generated symbols arrayed in multiple symbol columns and rows can be individually replaced after an initial array of symbols is generated. An apparatus to implement Applicant's electronic slot machine game includes a monitor for displaying the array of symbols, a memory which stores a list of possible symbols, a

microprocessor to select symbols from the memory, a first switch to initiate game play and a second switch to allow for a respin of selected symbols. In one alternative embodiment, both the symbols and their background colors can be respun to add further variability and enjoyment to the game.

2. The Cited Art Distinguished

Claims 1-9 and 11-17 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Dabrowski's U.S. Patent No. 5,356,140 ("Dabrowski patent"). As noted by the Examiner, the Dabrowski patent discloses a video *poker* game. In the Dabrowski poker game, two poker hands are simultaneously dealt with one hand superimposed upon the other. The player then chooses which hand to play and "the unselected hand is voided or removed from use" (Dabrowski patent abstract).

Applicant's invention is *not* directed to a video poker game but rather a variation of the popular electronic slot machine. To make this point clear, Applicant has stated in each of his claims that the monitor displays a plurality of symbols "arrayed in multiple symbol columns and rows." The Dabrowski video poker game, like other video poker games, does not have a plurality of symbols "arrayed in multiple symbol columns and rows." Instead, Dabrowski shows only a *single* row of superimposed cards at the beginning of the game which quickly becomes simply a single row of individual cards. As such, since the Dabrowski patent discloses an entirely different game than being claimed by Applicant, the Dabrowski patent does not anticipate Applicant's claims 1-9 and 11-17.

Claims 10, 18, and 19 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Manship's U.S. Patent 5,393,061 ("Manship patent"). The Manship patent discloses a slot machine game having display colors. In a so-called "Fever Mode," Manship's display colors are enhanced and the payout table is changed (see, col. 5, lns. 13-41 and col. 7). Like other common slot machines, there is no provision in the Manship patent for allowing the player to select one or more symbols after the initial spin for replacement. As such, Manship's slot machine is entirely a game of chance whereas Applicant's respin slot machine involves an important element of skill (i.e., choosing which slot machine symbols to replace). Moreover, as set forth in Applicant's claims 18 and 19, the background colors in this embodiment of Applicant's invention are a feature which can be selected for replacement and also constitute

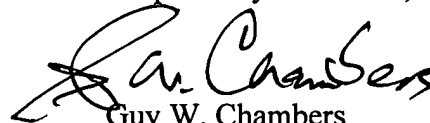
an active part of determining a winning combination. By contrast, Manship's enhanced display colors are entirely for show and take no part in determining a winning combination. For these reasons, the Manship patent does not anticipate Applicant's claims 10, 18 and 19.

Applicant notes that claims 20-22, 24 and 26-30 have been determined to be allowable over the prior art and that claims 23 and 25 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112. Applicant thanks the Examiner for these indications of allowable subject matter.

CONCLUSION

In light of the previous remarks and amendments to the claims, Applicant submits that the present application is now in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. To the extent that the Examiner believes that there are still formal matters or issues of patentability remaining, the undersigned attorney requests the opportunity for an interview with the Examiner to discuss these issues. The undersigned attorney for Applicant can be reached at (415) 576-0200 to schedule such an interview.

Respectfully submitted,

  
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